

REMARKS

The Final Office Action dated March 5, 2009 has been received and carefully considered.

Claims 1-69 are pending in the application. Claims 1-69 stand rejected. No new matter has been added. Entry of the amendments to the claims and reconsideration of the outstanding rejections in the present application are requested based on the following remarks¹.

Claim Objections

On page 2 of the Office Action, claims 1, 25, 44, 50, 59, 60, and 61 are objected to because the lines are crowded too closely together. Applicant notes that the claims were one-half spaced in accordance with 37 C.F.R. §1.52(b). However, to make reading the claims easier and to address the Examiner's objections, Applicant has increased the line spacing in the claims to double spacing in the attached claim listing and submit this overcomes the Examiner's objection.

Rejection of Claims 1-17, 24-25, 28-38, 44-50, 54-63, and 65-69 under 35 U.S.C. § 102(e)

Claims 1-17, 24-25, 28-38, 44-50, 54-63, and 65-69 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,138,106 ("Walker"). This rejection is hereby respectfully traversed.

In order to maintain an anticipatory rejection under 35 U.S.C. §102, a reference must teach each and every element of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (a claim is anticipated only if each and every element as

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

set forth in the claim is found, either expressly or inherently described, in a single prior art reference). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” MPEP § 2131 (quoting Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The Federal Circuit recently reiterated the standard for anticipation under 35 U.S.C. §102 in Net Moneyin v. Verisign, 88 USPQ2d 1751, 1759 (Fed. Cir. 2008), stating:

We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Furthermore, a “reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” Sanofi-Synthelabo v. Apotex, Inc., 89 USPQ2d 1370, 1375 (Fed. Cir. 2008) (emphasis and alterations in original) (quoting In re Arkley, 172 USPQ 524 (CCPA 1972)).

Independent claim 1 is set forth above. Claim 1 recites “a database resident at the remote station, wherein the database stores ones of the uniquely identifying codes that have been previously received from one or more user stations.” Walker discloses that “product database 28 is seen to include three records 60A, 60B, and 60C, each including four data fields: an item code filed 62.” Col. 5, lines 8-11. Walker further discloses that “[p]roduct database 28 is used to track data relating to items in the gift program.” Col. 5, lines 12-13. Walker discloses that “the product descriptors are used to inform the redeemer of products available for purchase with the gift certificate code.” Col. 9, lines 26-28. Applicant notes that the product database of Walker is already populated with the product information and the product codes that are stored are not *previously received from one or more user stations*. The Examiner alleges that Walker’s

disclosure of the processor receiving a product code at column 2, lines 40-67 discloses this claim element. However, Applicant submits that a processor receiving a product code fails to disclose a *database* storing a uniquely identifying code. Therefore, Walker fails to disclose “wherein the database stores ones of the uniquely identifying codes that have been previously received from one or more user stations.”

Further, Walker discloses “the memory stores a plurality of product codes for identifying products.” Col. 2, lines 44-45. Walker further discloses “[t]he processor receives data identifying a first product code from the first subset of product codes.” Col. 2, lines 51-53. This disclosure of Walker fails to indicate where the processor receives the data from and it fails to disclose that the memory *stores* the first product code. Applicant submits that the product codes are already stored in the memory of Walker and first product code is used for identification of the product. Based upon the response to arguments on page 11 of the Office Action, Applicant respectfully submits that the Examiner has misunderstood the disclosure of Walker. Accordingly, Walker fails to disclose the elements of the claimed invention as recited in the claim, as required for Walker to anticipate the claimed invention. Therefore, Walker fails to anticipate this element of the claimed inventions.

Claim 1 further recites the element of “wherein the database server credits an account of a user associated with the given user station with a non-zero valuation credit when such new candidate code received from the given user station was not previously stored in the database.” The Examiner alleges, on page 4 of the Office Action, that Walker discloses this element. Specifically, the Examiner alleges that Walker’s disclosure of “[t]he processor further operates to reduce the initial value by the product price of the first product code to provide a first adjusted value” (col. 3, lines 8-10) anticipates the recited element of the claimed inventions. The

Examiner alleges that reduce the initial value reads on *non-zero valuation credit*. Applicant disagrees. The claim recites the action of credit to an account with *a non-zero valuation credit*. Applicant submits that this is a different action from Walker's reducing an initial value of the product price. The adjusted value of Walker is based on the reduction in the initial credit value by the product price. Reducing and crediting are opposing actions. Walker therefore fails to disclose the claimed inventions with the same elements arranged or combined as recited and hence, Walker fails to anticipate the elements of independent claim 1.

Rejected claims 2-17 and 24 depend from independent claim 1 and thus incorporate the elements of independent claim 1, and are allowable for at least the reasons set forth above. Moreover, these claims recite additional features that are not disclosed or suggested by the cited reference.

Independent claims 25, 44, 50, 59, 60, and 61, though differing in scope, recite similar elements to independent claim 1, and are therefore allowable for at least the reasons given for independent claim 1 above. Dependent claims 28-38, 44-49, and 54-58 depend from independent claims 25, 44, and 50, and thus incorporate all the elements of the respective independent claims and are therefore allowable for at least the reasons set forth above.

Independent claim 61 recites the element of "wherein said at least one product is transacted in exchange for multiple resource types included in said account." Walker discloses the use of "gift certificates, purchasable by a buyer, represent a value stored in a database." Abstract. Applicant submits that Walker's stored value gift certificates do not represent *multiple resource types included in said account* as defined by the claimed inventions. Therefore, Walker fails to anticipate claim 61, for at least this reason, and Applicant respectfully requests the withdrawal of the anticipation rejection of independent claim 61.

The Examiner furthermore alleges on page 13 of the Office Action that “ ‘new candidate code received from a given user station’ reads on at least one product is transacted.” Applicant notes that this limitation does not appear in the claim and therefore the Examiner is importing a limitation into the claim that is not present. Also, as Applicant has previously noted, the Examiner has failed to address each and every element of the claims in the rejection; instead, the Examiner has merely lumped the claims together into one rejection for this one reference.

Dependent claims 65-69 depend from independent claim 61, and is allowable for at least the reason set forth above.

Rejection of Claims 18-22, 26-27, 39-42, 51-53, and 64 under 35 U.S.C. 103(a)

Claims 18-22, 26-27, 39-42, 51-53, and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Official Notice. Applicant respectfully traverses these rejections.

Claims 18-22, 26-27, 39-42, 51-53, and 64 are dependent upon at least one of independent claims 1, 25, 44, 50, and 61, and thus inherently incorporate all of the limitations of the independent claims. Also, the secondary reference (i.e., Official Notice) fails to disclose, or even suggest, the deficiencies of the primary reference as discussed above with respect to independent claims 1, 25, 44, 50, and 61. Accordingly, claims 18-22, 26-27, 39-42, 51-53, and 64 are allowable over the combination of the secondary reference with the primary reference at least by virtue of their dependency on independent claims 1, 25, 44, 50, and 61.

Rejection of Claims 23 and 43 under 35 U.S.C. 103(a)

Claims 23 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of U.S. Patent No. 6,321,211 (“Dodd”). Applicant respectfully traverses these rejections.

Claims 23 and 43 are dependent upon independent claims 1 and 25, respectively, and thus inherently incorporate all of the limitations of the independent claims. Also, the secondary reference (i.e., Dodd) fails to disclose, or even suggest, the deficiencies of the primary reference as discussed above with respect to independent claims 1 and 25. Accordingly, claims 23 and 43 are allowable over the combination of the secondary reference with the primary reference at least by virtue of their dependency on independent claims 1 and 25.

CONCLUSION

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether personal or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Amendment. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicant also authorizes the Director to charge all required fees, fees under 37 C.F.R. §1.17, and all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

Date:

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